REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion and in view of the present amendment is respectfully requested.

Claims 6-16 are pending in this application. Claims 6 and 10 are amended and Claims 1-5 are canceled by the present amendment.

In the outstanding Office Action, Claims 6-16 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement; Claims 6, 7, 11, and 13 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,751,453 to Schemers et al. (herein "Schemers"); Claim 8 was rejected under 35 U.S.C. § 103(a) as unpatentable over Schemers in view of U.S. Patent No. 5,199,062 to Von Meister et al. (herein "Von Meister"); Claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over Schemers in view of U.S. Patent No. 5,003,577 to Ertz et al. (herein "Ertz"); Claims 10, 14, and 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over Schemers in view of Google Groups, April 18-19, 1999 (herein "Google"); Claim 12 was rejected under 35 U.S.C. § 103(a) as unpatentable over Schemers in view of U.S. Patent No. 6,501,832 to Saylor et al. (herein "Saylor"); and Claim 15 was rejected under 35 U.S.C. § 103(a) as unpatentable over Schemers in view of Google and Saylor.

Initially, Applicants and Applicants' representative gratefully acknowledge the courtesy of a personal interview with Primary Examiner Winder and Examiner Bhatia on March 12, 2008. During the interview, the rejections in the Office Action were discussed, and differences between the references in the Office Action and the claimed inventions were discussed. Comments and claim amendments discussed during the interview are reiterated below.

Applicants respectfully traverse the rejection of Claims 6-16 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

The enablement requirement of 35 U.S.C. § 112, first paragraph, has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). As noted in MPEP § 2164.01(a), factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement include, but are not limited to the state of the prior art, the level of one of ordinary skill, and the existence of working examples.

As discussed during the interview, the level of one of ordinary skill in the art includes the capability to make or user an email server with the ability to accept incoming phone calls, as evidenced by the references cited in the Office Action, which provide a working example. For example, U.S. Patent 5,717,742 to Hyde-Thomson, which was referred to in U.S. Patent 6,351,523 to Detlef cited in the Office Action, describes an electronic mail system having integrated voice messages in which

> the APIs of a commercially available E-mail system and the ability to attach voice files as part of an E-mail message are used to implement a voice messaging system. The voice file is created by using a board in a PC which connects to a phone system to accept incoming phone calls and to convert the analog voice signal into a digital format.[1]

Thus, a method of making an email server having a connection to a phone system to accept incoming phone calls was known in the at the time of the invention, and was achievable without undue experimentation. Accordingly, it is respectfully requested the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

Applicants respectfully traverse the rejection of Claims 6, 7, 11, and 13 under 35 U.S.C. § 102(e) as anticipated by Schemers.

Claim 6 is directed to a method for enabling a portable electronic device to communicate with an enterprise terminal of an enterprise. The method includes, in part,

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[1] Hyde-Thomson at column 3, lines 35-41.

receiving a call in an email server from the portable electronic device, and obtaining, at the email server, a pre-assigned message identifier from the portable device that identifies the pre-assigned message identifier assigned by the e-mail server to an e-mail message provided to the portable electronic device from the email server. The pre-assigned message identifier corresponds to an author of the received email. Independent Claim 10 includes similar features.

Applicants' Figures 1-3 show non-limiting embodiments of a method for enabling a recipient's cell phone 22 (e.g., a portable electronic device) to communicate with a sender's terminal 10 (e.g., an enterprise terminal). In this example, the sender's terminal 10 may send an email to recipient's cell phone 22 via the sender's email server 12. Further, in this example, a message-specific indicia 890 (e.g., pre-assigned message identifier) is assigned to the email message received by the recipient's cell phone 22 (e.g., the portable electronic device) from the sender's email server 12 (e.g., email server). Further, in this example, a reply notice prompts the operator of the recipient's cell phone 22 to dial a phone number that is received by the email server and enter the message identifying number "890" that corresponds to an author of the email received at the recipient's cell phone 22. Further, the operator of the recipient's cell phone 22 may record a voice response.

In other words, in this non-limiting embodiment, the message identifying number "890" corresponds to an author who sent the email message from sender terminal 10. When the operating recipient's cell phone 22 calls the phone number, the call is received at the sender's email server 12 from the recipient's cell phone 22. Further, in this example, the sender's email server obtains the pre-assigned message identifier from the portable electronic device when the operator of recipient's cell phone 22 enters the message identifying number "890" (e.g., pre-assigned message identifier). Further, the message identifier obtained at the email server is the message identifier assigned by the email server to the email message

8

received by the recipient's cell phone 22 (e.g., the portable electronic device) from the sender's email server 12 (e.g., email server), and the message identifier corresponds to an author of the received email (e.g., the operator of sender terminal 10).

As discussed during the interview, Schemers fails to teach or suggest each of the features of independent Claims 6 and 10. For example, Schemers fails to teach or suggest obtaining a pre-assigned message identifier from a portable electronic device, and Schemers fails to teach or suggest that an email message received by a portable electronic device from a server is assigned a message identifier by the server. In addition, as discussed during the interview, Schemers fails to teach or suggest that the pre-assigned message identifier corresponds to an author of the email received at the portable electronic device.

Schemers describes a system, method, and apparatus for retrieving messages at a mobile station.[2] In particular, Schemers indicates that a messaging system 100 includes a mobile device 140 connected to a gateway server 150 and a gateway switch 138 via a cellular network 145.[3] Further, Schemers indicates that a web server 105 is connected to the gateway server 150 via an internet 135, and a telephone server 115 is connected to a gateway switch 148 via a public switch telephone network (PTSN) 120. In particular, Schemers indicates that a wireless application protocol (WAP) session is established with the gateway server 150 and a client/server connection is established between the mobile station 140 and the web server 105 with the gateway server 150 acting as a proxy client.[4] Further, according to Schemers, a script program 130 at the web server 105 shows a number of objects for display at the mobile station 140 and a graphical user interface.[5] In addition, Schemers indicates that

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[2] Schemers at Abstract.
[3] Schemers at Figure 1.
[4] Schemers at column 4, lines 38-43.
[5] Schemers at column 4, lines 46-50.

9

a subscriber can view and respond to emails by selecting one of the WAP session graphical

objects, in particular the voice object 312.[6]

Schemers indicates that each email indicator 308 in the GUI 300 includes a respond to

email by voice object 312.[7] Schemers further indicates that when the response to email by

voice object 312 is selected, the operation is initiated by transmitting a signal to the web

server 105 (i.e., signal 605).[8] After receiving the voice object 312, the web server 105

prepares an email to be sent in the response and in addition, and the web server 105 transmits

the phone number of the mobile station 140 to a state server 110 that stores a record including

the recipient's phone number.

In other words, according to Schemers, a web server receives a signal from a

recipient's cell phone where the signal indicates that the recipient desires to respond to an

email with a voice object (i.e., email by voice object 312). However, Schemers fails to

suggest that a pre-assigned message identifier is obtained by the web server or the state server

or the pre-assigned message identifier is assigned by the email sender to the email message

received by the recipient's phone, or that the pre-assigned message identifier corresponds to

an author of the received email. That is, the web server of Schemers is described as

obtaining the phone number of the recipient and preparing an email which will be sent from

the recipient to the sender of the email message.

Further, the email address of the sender of the email is not a message identifier

assigned by the email sender to an email message received by the portable electronic device

from the email server. Instead, the email address identifies the email sender and does not

identify the message itself. For example, plural messages sent from the sender may have a

same sender's email address and different message identifiers.

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[6] Schemers at column 6, lines 33-35.
[7] Schemers at column 5, lines 13-14.
[8] Schemers at column 6, lines 38-42.

Further, Applicants respectfully traverse the assertion in the Office Action that

Schemers teaches authenticating the message identifier at the email server in Schemers at

column 3, lines 57-67. The cited portion of Schemers recites that a GUI facilitates entry of

inputs from the client terminal and outputs from the web server 105 at the client terminal, and

the inputs can include data which identifies the user, "e.g., a user ID, a password, or personal

identification number."[9] In other words, Schemers indicates that the GUI may be used to

input data which identifies a user, which is different than the claimed pre-assigned message

identifier that is assigned by an email server to an email message and which corresponds to

an author of the email message. For example, in the non-limiting embodiment discussed

above, an operating recipient's cell phone 22 may call a reply telephone number and enter a

message identifier number "890" when prompted. Thus, the email server obtains the pre-

assigned message identifier from the portable electronic device.

Further, Applicants' Figure 3 at decision point 224 shows an example in which the

system may determine if the message identifying serial number is valid. Thus, according to

this example, the email server authenticates the pre-assigned message identifier. On the other

hand, Applicants respectfully submit that Schemers also fails to teach or suggest

authenticating a pre-assigned message identifier that is assigned to an email message by an

email server and received by a portable electronic device.

Therefore, Applicants respectfully submit that Schemers fails to teach or suggest each

of the features of independent Claims 6 and 10. Thus, Applicants respectfully request the

rejection under 35 U.S.C. § 102(e) be withdrawn.

Further, Applicants respectfully traverse the rejections of Claims 8-10, 12, and 14-16

under 35 U.S.C. § 103(a) as unpatentable over Schemers in view of Von Meister, Ertz,

Google and/or Saylor.

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[9] Schemers at column 3, lines 63-66.

11

Claims 8-10, 12, and 14-16 depend from independent Claims 6 or 10, which as discussed above are believed to patentably define over <u>Schemers</u>. Further, Applicants respectfully submit that <u>Von Meister, Ertz, Google</u> and <u>Saylor</u>, whether taken individually or in combination, fail to supply the claimed features lacking in the disclosure of <u>Schemers</u>.
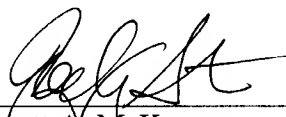
Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been presented. Therefore, Applicants respectfully request the rejections of Claims 8-10, 12, and 14-16 under 35 U.S.C. § 103(a) be withdrawn.

Therefore, Applicants respectfully submit that independent Claims 6 and 10, and claims depending therefrom, are allowable.

Consequently, in light of the above discussion and in view of the present amendment, this application is believed to be in condition for allowance, and a favorable action to that effect is respectfully requested.

Respectfully submitted,

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